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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,876

09/22/2003

Michael Johnson

1975/US

3615

20686

7590

07/14/2006

DORSEY & WHITNEY, LLP
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DENVER, CO 80202-5647

EXAMINER

BERTRAM, ERIC D

ART UNIT

PAPER NUMBER

3766

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/668,876	Applicant(s) JOHNSON, MICHAEL	
	Examiner Eric D. Bertram	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 15-17 in the reply filed on 6/22/2006 is acknowledged. The traversal is on the ground(s) that burden on the Examiner to search all of the original claims has not been established. This is not found persuasive because burden is established if the inventions have a separate classification (see MPEP 808.02). As stated in the Restriction Requirement, Group I, claims 1-14, drawn to a method for forming electrodes, is classified in class 607, subclass 116, while Group II, claims 15-17, drawn to a catheter, is classified in class 600, subclass 585.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/22/2006.

3. The addition of new claims 18-30 is acknowledged and accepted, and as a result, claims 15-30 will be examined in this detailed action.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 5/20/2004 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

5. Claim 15 is objected to because of the following informalities: In line 5 of the claims, it appears that "on" should be replaced with --one--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 15, 17-23, 25-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Black et al. (US 6,216,045, hereinafter Black). Black discloses a catheter for use in a medical procedure, including a catheter body 22 and a catheter tip 34 operably connected to the catheter body. Black further discloses arbitrarily-shaped electrodes 18 attached to the catheter, wherein the electrodes, along with the entire catheter assembly is overmolded (Col. 7, lines 5-11). Energy is delivered to the electrodes through wire conductors 20 (Col. 4, lines 3-17).

8. Regarding claims 17, 21-23, 25 and 26, Black discloses that the catheter body comprises a lumen tube 24 nested in jacket 23, wherein the wire conductors 20 are located on the exterior surface of the lumen tube (see figure 3). Black shows in figure 5 that the electrodes 18 must pass through the jacket 23 to contact the conductors.

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9. Regarding claim 18, the electrodes must inherently be exposed from the overmold of the catheter to allow the electrodes to electrically stimulate the body (Col. 1, lines 5-10).

10. Regarding claims 19 and 20, Black discloses that the electrodes are composed of biocompatible, conductive material, specifically platinum (Col. 3, lines 40-45).

11. Regarding claims 27, 29 and 30, it is the Examiner's position that the wire conductors are inherently traces, given its broadest reasonable interpretation.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 16 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black. Black, as described above, discloses the applicant's basic invention with the exception of electrodepositing the electrodes and traces onto the catheter.

However, it would have been an obvious matter of design choice to modify Black by

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electro-depositing the traces and electrodes onto the catheter since, upon reviewing the specification, the applicant has not disclosed that electro-depositing the traces and electrodes solves any stated problem or is for any particular purpose, and it appears that the catheter would perform equally well no matter how the electrodes or the traces have been attached to the catheter.

15. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black in view of Quackenbush (US 5,125,913). Black, as described above, discloses that applicant's basic invention, including a catheter comprising a tube along which wire is run. Black does not disclose, however, that the tube and wire are co-extruded. Attention is directed to the secondary reference of Quackenbush, which discloses the use of co-extrusion when forming a medical catheter. Therefore, it would have been obvious to one of ordinary skill in that art at the time of the applicant's invention to modify the catheter of Black by co-extruding the tube and wire as suggested by Quackenbush because co-extrusion is a cheaper process since two steps can be completed in a single step.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D. Bertram whose telephone number is 571-272-3446. The examiner can normally be reached on Monday-Thursday and every other Friday from 9-6:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric D. Bertram
Examiner
Art Unit 3766



Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3766

EDB